



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/622,273

07/17/2003

Yumiko Kikuoka

59614 (49381)

4208

21874

7590

04/30/2007

EDWARDS ANGELL PALMER & DODGE LLP

P.O. BOX 55874

BOSTON, MA 02205

EXAMINER

DICKER, DENNIS T

ART UNIT

PAPER NUMBER

2609

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

04/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/622,273	KIKUOKA, YUMIKO	
	Examiner	Art Unit	
	Dennis Dicker	2609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,12-18 and 25-33 is/are rejected.
- 7) ☒ Claim(s) 2-4 and 19-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/31/2005; 7/17/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 6-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. As per Claim 6, the claim contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The means for determining whether character information is included in an image so it could be included with generated summary information is not explained in the Specification.

In addition Claim 7 contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The summary document processing means in the present claim is not explained in the Specification. This rejection also affects dependent claim 8.

In addition Claims 9-11 contain subject matter, which were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

invention. The summary document generating means and the E-Mail processing means are not explained in the Specification.

2. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The summary document generating means and the E-mail processing means in the present claim are not explained in the Specification.

3. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The summary document generating means and the E-mail processing means in the present claim are not explained in the Specification.

4. Claims 15 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter, which were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The summary document processing means in the present claims is not explained in the Specification.

5. Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter, which was

Art Unit: 2609

not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The summary document generating means and the E-mail processing means in the present claim are not explained in the Specification.

6. Claims 31-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. While claims 31-33 are claiming a memory product no new structural component or improvement to the device is claimed, but rather a program recorded thereon, and as such it would not convey to one of ordinary skill in the art at the time when the invention was made how to make or practice this invention. In fact claim 31-33 is claiming a program or software recorded on a computer readable medium and performing something useful when executed on a computer.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2609

Claims 1, 5, 12-18, 25-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Katayuki (Jap Pub 2000-349952).

8. For Claim 1, Katayuki teaches an Image information distributing method for receiving information, which includes a central apparatus [0061-0062] and a terminal apparatus [0021-0026]. Katayuki then teaches summary image information which has been scaled and indicates its location information [0016] then later explaining how the summary information can be sent through a communication means by E-Mail.

9. For claim 5 Katayuki [0023] and further in [Figure 2] explains how the input/output system has a plurality of terminals that can receive the summarized image data through the communication means in this case a LAN. The terminals have a display, which in the reference invention is a CRT display device.

10. For claim 12 Katayuki [0061-0062] teaches a storage server that communicates by a LAN stores image information and when the request is made to send the image information then transmits the image information to users browser at the terminal PC.

11. For claim 13 Katayuki teaches a storage server [0061-0062]. Katayuki then teaches how the central apparatus generates a summary document and has a notice means, which processes the summary information for communication with another user by such means as E-mail. [0016].

12. For claim 14 Katayuki [0023] and further in [Figure 2] teaches how the input/output system has a plurality of terminals that can receive the summarized image data through the communication means. Katayuki then teaches [0019] how the user

Art Unit: 2609

sends the transmitting instruction from the terminal apparatus to a storage server via a communication means [0021-0026].

13. For claim 15 Katayuki [0023] and further in [Figure 2] explains how the input/output system has a plurality of terminals that can receive the summarized image data through the communication means in this case a LAN. The terminals have a displayer, which in the reference invention is a CRT display device.

14. For claim 16 Katayuki explains [0061-0062] how a storage server that communicates by LAN stores image information and when the request is made from a terminal PC to send the image information. The central PC then transmits the image information to the users browser at the terminal PC.

15. For claim 17 Katayuki explains how a system which comprises a scanner for generating image information and outputting said image information to the input/output apparatus for receiving and storing the transmitted image information and transmitting E-mail to the terminal device including the control unit; and a terminal apparatus; wherein they are connected by a LAN [0021-0026].

16. For claim 18 Katayuki [0021-0026] explains how the system comprises a scanner for generating image information and outputting said image information to the input/output apparatus for receiving and storing the transmitted image information and transmitting E-mail to the terminal device including the control unit; and a terminal apparatus; wherein they are connected by a LAN.

17. For claim 25 Katayuki [0021-0026] teaches an input/output system comprising a controller (corresponds to the processor) and a storage device. The hardware structure

Art Unit: 2609

in the present claim has been disclosed in Katayuki's Invention. The only difference between the present claim and the referenced invention lies in that the operations executed by the processors are different. However, such difference does not bring any change or improvement in hardware structure to the apparatus sought for protection.

This rejection also affects dependent claims 26. For claim 26 they do not show any new or improvements to the limitations of what is being claimed by the processor. They simply explain more features of what the processors can do.

18. For claim 27 Katayuki teaches the terminal apparatus includes a network device used for communication and a control unit. The hardware structure in the present claim has been disclosed in Katayuki's Invention. The only difference between the present claim and the referenced invention lies in that the operations executed by the processors are different. However, such difference does not bring any change or improvement in hardware structure to the apparatus sought for protection.

19. For claim 28 Katayuki [0021-0026] teaches the terminal apparatus includes a display and a control unit. The hardware structure in the present claim has been disclosed in Katayuki's Invention. The only difference between the present claim and the referenced invention lies in that the operations executed by the processors are different. However, such difference does not bring any change or improvement in hardware structure to the apparatus sought for protection.

20. For claim 29 Katayuki [0023] teaches the terminal apparatus comprises a network interface device for communication. The hardware structure in the present claim has been disclosed in Katayuki's Invention.

Art Unit: 2609

21. For claim 30 Katayuki [0021-0026] teaches the scanner comprises a controller, which is known by someone in the art as a "processor", and a means for communication. The hardware structure in the present claim has been disclosed in Katayuki's Invention. The only difference between the present claim and the referenced invention lies in that the operations executed by the processors are different. However, such difference does not bring any change or improvement in hardware structure to the apparatus sought for protection.

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katayuki (Jap Pub 2000-349952).

For claim 31 Katayuki teaches how a browser enables the computer to receive and store image information [0045-0046], Katayuki further explains how after a transfer request is made and original of the image file is transmitted to the terminal computer via a hypertext, which specifies the storage information of contracted image [0060-0062].

For claim 32 Katayuki teaches how a browser on a computer receives and transmits information [0045-0046], then teaches how the summary of image information

Art Unit: 2609

is then created [0030-31], [0038]. Katayuki also teaches how the generated summary document is the prepared to be transmitted via E-mail [0059].

For claim 33 Katayuki teaches how a browser on a computer displays the hypertext, which includes the location information corresponding to the image information [0063].

While Katayuki does not specifically teaches that a browser software is implemented by recording it onto a memory product It would have been obvious to someone of ordinary skill in the art at the time the invention was made that the browser taught by Katayuki is a type of computer program that would be on some type of memory when installed on a personal computer. It is also known that in order for a executable program to be able to run on a computer it must be stored on a hard drive or some other type of computer storage device.

Allowable Subject Matter

24. Claim 2-4 and 19-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: none of the references, either singularly or in combination, teach or fairly suggest an image information distributing system and associated with it method, wherein the method includes steps of determining whether character information is included in image information or not; and in the case where character information is

Art Unit: 2609

included in the image information, making the character information to be included in the summary document.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Dicker whose telephone number is (571) 270-3140. The examiner can normally be reached on Monday - Friday 7:30 A.M. to 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Eisen can be reached on (571) 272-7687. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Art Unit: 2609

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Alexander Eisen", with a stylized flourish at the end.

Alexander Eisen
SPE
Art Unit 2609

DD

4/25/2007